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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,163	11/03/2003	John William Miller	06459P USA	3630
23543	7590	11/23/2004	EXAMINER	
AIR PRODUCTS AND CHEMICALS, INC.			COONEY, JOHN M	
PATENT DEPARTMENT			ART UNIT	
7201 HAMILTON BOULEVARD			PAPER NUMBER	
ALLENTOWN, PA 181951501			1711	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/700,163

Applicant(s)

MILLER, JOHN WILLIAM

Examiner

John m Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4 shfs.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants do not provide disclosure enabling for their various aliphatic, cycloaliphatic, and araliphatic groups to be nitrogen or oxygen atoms.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 10, 12-14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornet et al. (6,034,145).

Cornet et al. disclose compositions for the preparation of polyurethane foams wherein hydroflourocarbon blowing agent, monols reading on the enhancers claimed, and silicon surfactants are combined in a manner which reads on the compositions claimed (see the entire document).

Claims 1-6, 10, 12-14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Patterson ('071),('817), & ('562), each taken individually.

The Patterson patents disclose compositions for the preparation of polyurethane foams wherein hydroflourocarbon blowing agent, monols reading on the enhancers claimed, and surfactants are combined in a manner which reads on the compositions claimed (see each of the documents taken individually in their entirety). Specific silicone surfactant additives claimed by applicants can be readily envisioned from the teachings of the cited references.

Claims 1-6, 10, 12-14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ramey et al.(3,875,086).

Ramey et al. disclose compositions for the preparation of polyurethane foams wherein hydroflourocarbon blowing agent, monols reading on the enhancers claimed, and other materials are combined in a manner which reads on the compositions claimed (see the entire document). Specific hydrofluorocarbons claimed by applicants and the

well known silicon surfactant materials are readily envisioned from the teachings of the cited reference.

Claims 1-6, 10, 12-14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/26,913 A2.

WO 02/26,913 A2 disclose compositions for the preparation of polyurethane foams wherein hydroflourocarbon blowing agents, compounds reading on the enhancers claimed, and additives are combined in a manner which reads on the compositions claimed (see the entire document). Specific silicone surfactant additives claimed by applicants can be readily envisioned from the teachings of the cited reference.

Claims 1-6, 10, 12-14, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by PG PUB 2003/0,078,312.

PG PUB 2003/0,078,312 discloses compositions for the preparation of polyurethane foams wherein hydroflourocarbon blowing agents, compounds reading on the enhancers claimed, and stabilizers are combined in a manner which reads on the compositions claimed (see the entire document).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-6, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornet et al. (6,034,145), Patterson ('071),('817), & ('562), Ramey et al., WO/02 26,913, and PGPUB 2003/0,078,312, each taken individually, as applied to claims 1-6, 10, 12-14, and 18 above, and further in view of Brunnemann et al.('802).

Claims differ from each of Cornet et al., Patterson ('071) and ('817), and Ramey et al. in that the specific additives are not recited as being employed. However, Brunnemann et al. discloses the employment of these various materials in urethane synthesis for their solvent effect (see column 8 line 66-column 9 line 8, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the solvents disclosed by Brunnemann et al. for the purpose of imparting their solvent effect in the materials of Cornet et al., Patterson ('071),('817),&('562), Ramey et al., and WO/02 26,913, and PGPUB 2003/0,078,312 in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/672,363. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in a manner which would have been obvious to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

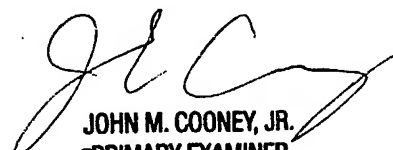
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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Boehme et al. discloses employment of alcohols as agents in urethane synthesis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN M. COONEY, JR.  
PRIMARY EXAMINER  
Group 1700